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10/534,425	05/10/2005	Harald Goscbruch	47588-214072	5010

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EXAMINER	
HESSE, CAROL	

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2876	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/534,425	GOSEBRUCH ET AL.	
	Examiner	Art Unit	
	Carol Hesse	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 May 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-50* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 May 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited.(PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Supplemental Office Action

The examiner recognizes the amendment filed before the first non-final office action, submitted 10 May 2005.

Claim Objections

1. Claim 42 is objected to because of the following informalities: the phrase "the storage mean" is used in this claim however, claims 37, and 40-41 do not recite a storage means.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 18 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Regarding claims 18 and 39, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 6-16, 18-19, 21-22, 24, and 26-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Moore (Patent No.: US 6,246,778 B1).

7. With respect to claim 1, Moore discloses:

- Article which is provided with an individual marking for identification (col. 10, lines 14-30), characterized that the marking is a random identifier peculiar to the article (col. 22, lines 61-67)).

8. With respect to claim 2, Moore discloses claim 1, and:

- Article characterized in that the article is a package (col. 10, lines 26-30).

9. With respect to claim 3, Moore discloses claim 1 and:

- The random identifier forms part of the design of the package (col. 16, lines 47-52).

10. With respect to claim 4, Moore discloses claim 1, and:

- The random identifier is composed of at least one random pattern (col. 19, line 65- col. 20, line 2).

11. With respect to claim 6, Moore discloses claim 4, and:

- In addition to the random pattern a marking generated from the random pattern (col. 19, line 65- col. 20, line 2) is arranged on the package (col. 10, lines 24-30).

12. With respect to claim 13, Moore discloses claim 1, and:

- The random identifier is an integral part of the package itself (marked directly on package, col. 11, lines 26-29).

13. With respect to claim 14, Moore discloses claim 1, and:

- The random identifier is arranged in a predefined region of the package (col. 19, lines 25-54).

14. With respect to claim 16, Moore disclose claim 15, and:

- The coding and/or marking means and/or marking are arranged on the primary packaging and/or secondary packaging and/or tertiary packaging (col. 18, lines 21-30) is such a way that they can be clearly identified from the outside (marking is read when leaving plant gates or at a point of distribution or sale, meaning articles are packaged and not opened, col. 12, lines 37-47).

15. With respect to claim 18, Moore discloses claim 3, and:

- The random pattern is a gap width of folds (marking is placed in relation of folds of packaging, Fig. 2, col. 19, lines 25-37).

16. With respect to claims 19 and 37, Moore discloses:

- A method and device for individual markings of articles (col. 9, lines 54-61), in particular packages, with an individual marking means (col. 10, lines 24-30), characterized in that a means/method is provided for detecting at least one

random identifier peculiar to the article, in particular to the package, as a marking means, conversion of a random identifier to an individual marking (col. 11, lines 1-11), a means for generating and displaying or outputting a marking from the random identifier (col. 11, lines 5-14), and means for filling or depositing the marking as a data record in a data bank (col. 16, lines 64-67) and/or print on the article (col. 10, lines 57-61).

17. With respect to claim 26, Moore discloses claim 19, and:

- In addition to the random pattern and/or marking, a coding means, in particular a serial number, is applied (col. 15, lines 52-62).

18. With respect to claim 27, Moore discloses claim 26, and:

- The coding means/method is in a predetermined and reproducible relationship (correlation) to the marking means (clear text of host is stored, also encrypted to create encoded mark, col. 11, lines 1-11).

19. With respect to claim 28, Moore discloses claim 27, and:

- The correlation is formed by storage in a data bank (col. 10, lines 57-62, and col. 11, lines 39-45).

20. With respect to claims 15 and 30, Moore discloses claims 1 and 26, respectively, and:

- The package is composed of primary packaging and/or secondary packaging and/or tertiary packaging (col. 18, lines 21-30).

21. With respect to claim 22, Moore discloses claim 19, and:

- The marking is coded before printing on the package (col. 11, lines 5-14).

22. With respect to claim 29, Moore discloses claim 26 and:

- The package with coding means and/or marking means and/or marking takes place on-line or off-line (global process, Fig. 1a, col. 11, lines 32-36, local process, col. 11, lines 36-38).

23. With respect to claims 31 and 43, Moore discloses:

- Device and method for the identification of articles, in particular packages, provided with an individual marking means (col. 10, lines 19-30), characterized in that means is provided for detecting at least one random identifier peculiar to the article (col. 10, lines 34-35), in particular to the package (col. 22, lines 61-67), as a marking means, conversion of the random identifier to an individual marking (col. 11, lines 39-41), a means for generating and displaying or outputting a marking from the random identifier. (col. 10, lines 36-40, col. 11, lines 39-49), alignment of the marking with print on the article, the package (col. 10, lines 26-30), and/or a data recode filed in a data bank and containing the marking (col. 16, lines 64-67 and col. 12, lines 19-30).

24. With respect to claim 38, Moore discloses claim 37, and:

- A means for applying a random identifier is provided (col. 11, lines 1-14).

25. With respect to claim 39, Moore discloses claim 37, and:

- The means for deposition or filing includes a printer (col. 11, lines 1-3) and/or a storage means, in particular a data bank (col. 10, lines 57-59, and col. 16, lines 64-67).

26. With respect to claim 40, Moore discloses claim 37, and:

- In addition to means for applying a coding means is provided, wherein the means for applying the coding means can be identical with the printer for depositing the marking (col. 11, lines 1-3).

27. With respect to claim 41, Moore discloses claim 40, and:

- Means are provided for coding the marking (col. 11, lines 1-14).

28. With respect to claim 42, Moore discloses claim 41, and:

- The means for detecting at least one random identifier, the means for generating and displaying or outputting a marking, the storage means, the means for coding and the means for depositing or filing are operatively connected to each other, for which purpose the means are preferably linked together (components in communication with each other, col. 11, lines 1-14, 29-59).

29. With respect to claims 24, 32, and 44, Moore discloses claims 19, 31, and 43, respectively, and:

- The means/method for detecting is designed to emit UV (ultraviolet spectral range) light and, optically, pick up the information which is rendered visible (col. 23, lines 21-24).

30. With respect to claim 45, Moore discloses claim 43, and:

- The means for detecting is designed to detect further information located on the package, in particular the marking and a coding means (detect and decode symbol, col. 11, lines 53-55).

31. With respect to claims 21, 33, and 46, Moore discloses claims 19, 31 and 43, respectively, and:

- The means/method for generating and displaying or outputting is designed to carry out mathematical functions (decode and decryption), in such a way that the random identifier can be converted to the marking (col. 11, lines 39-59).

32. With respect to claim 35, Moore discloses claim 31, and:

- The method that in addition a coding means arranged on the package, in particular a serial number is detected (col. 15, lines 50-67).

33. With respect to claims 34 and 36, Moore discloses claims 31 and 35, and:

- The method in that the random identifier is scanned, wherein the associated marking is determined from the scanned information (data pair, coding means and marking means) and compared with print applied to package and/or a data record filed in a data bank (data pair) (col. 11, lines 39-45 and col. 12, lines 19-30).

34. With respect to claim 47, Moore discloses claim 43 and:

- A means is provided for decoding the marking (host interfaces with encrypting unit, col. 11, lines 39-59).

35. With respect to claim 48, Moore discloses claim 47, and:

- The means for detecting, the means for detecting, the means for generating and displaying or outputting, and the means for decoding are connected to a storage means, in particular a data bank (col. 11, lines 44-45).

36. With respect to claim 49, Moore discloses claim 48, and:

- The means for detecting, the means for generating and displaying or outputting, the storage means and the means for decoding are operatively connected to each other, wherein the means are preferably linked together (reader, output, database, and decoder are in communication with each other, col. 11, lines 29-59).

37. With respect to claim 50, Moore discloses claim 43, and:

- The device is designed as a mobile hand-held device (col. 9, lines 59-61, and col. 23, lines 54-56).

Claim Rejections - 35 USC § 103

38. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

39. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

40. Claims 5, 20, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore (Patent No.: US 6,246,778 B1) in view of Moore (Patent No.: US 6,456,729 B1).

41. With respect to claims 5, 20, and 25, Moore (Patent No.: US 6,246,778 B1) discloses claims 4 and 19.

Moore (Patent No.: US 6,246,778 B1) fails to explicitly disclose that the UV sensitive ink of the random identifier is composed of a distribution of luminophores.

Moore (Patent No.: US 6,456,729 B1) teaches that the random identifier is composed of a distribution of luminophores (fluorescent compounds col. 19, lines 2-5 and col. 21, lines 10-12).

It would have been obvious to a person having ordinary skill in the art to make combine Moore and Moore because the manufacturing operator will not know what kind of symbol has been printed and the ink can be overprinted with visible ink that makes the package appear unaltered (Moore US 6,456,729 B1, col. 17, lines 13-27).

42. With respect to claim 7, claim 5 is disclosed above. Additionally Moore disclose the distribution is detectable (col. 20, lines 22-26) and can be filed or deposited as an optionally coded or uncoded marking (col. 20, lines 8-16) in a data bank (col. 16, lines 64-67) and/or as print on the package (col. 10, lines 26-30).

43. With respect to claim 8, claim 7 is disclosed above. Further Moore discloses in addition to the random pattern and/or marking, a coding means, in particular a serial number, is applied (col. 15, lines 52-62).

44. With respect to claims 9-10, claim 8 is disclosed above. Additionally Moore discloses the coding means/method is in a predetermined and reproducible relationship (correlation) to the marking means (clear text of host is stored, also encrypted to create encoded mark, col. 11, lines 1-11).

45. With respect to claim 11, claim 10 is disclosed above. Futher Moore discloses the correlation is formed by storage in a data bank (col. 10, lines 57-62, and col. 11, lines 39-45).

46. With respect to claim 12, claim 10 is disclosed above. And, Moore discloses the correlation is formed by a coding function (encryption, col. 11, lines 1-11).

47. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore (Patent No.: US 6,246,778 B1) in view of Komiya et al. (US Patent No.: 6,155,025).

48. Regarding claim 17, Moore teach claim 16.

Moore fails to disclose a marking on a secondary packaging designed as a link number generated from the coding means and/or marking means and/or marking of the primary package.

Komiya et al. teach a link number on the secondary packaging generated from the marking of the primary packaging (pack ID is linked to the multiple package IDs, col. 22, lines 39-55).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Moore with Komiya et al. for the advantage of easily tracking which packs come from which boxes (Komiya et al. col. 22, lines 56-64).

49. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore (Patent No.: US 6,246,778 B1) in view of Neway et al. (Patent No.: US 6,243,615).

50. With respect to claim 23, claim 19 is disclosed above. Moore also disclose compression of the image captured by the reader before the process of comparing the compressed captured data to the data stored in the data bank (col. 11, lines 31-36).

51. However Moore fails to explicitly state that the marking stored in the data bank is compressed before storage.

Neway et al. teach data compression before storing in a data bank (col. 6, lines 36-40).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Moore with Neway et al. for the benefit of reducing the amount of storage space needed (Neway et al., col. 6, lines 36-40).

Conclusion

52. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Afzali-Ardakani et al. (Patent No.: US 6,746,053 B1) disclose an authenticating marking system with luminous ink deposited in the form of an encrypted bar code containing a serial number.
- Colgate, Jr. (US Patent No.: 4,462,851) discloses a method for placing tax stamps on individual packs in a carton, so that they are visible without opening the carton.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carol Hesse whose telephone number is 571-272-9788. The examiner can normally be reached on Monday-Thursday 7:30-5:00, e/o Friday 7:30-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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